

Application No.: 10/664142

Case No.: 54493US011

REMARKS

Claims 24-26 and 29-34 have been canceled. Claims 27 and 28 have been amended. Claims 35-40 have been added. Claims 27, 28, and 35-40 are pending. Applicant acknowledges that originally numbered claims 37-47 have been renumbered 24-34. Because all but claims 27 and 28 have been canceled, only the rejections relating to these claims are discussed below.

§ 112 Rejections

Claim 28 stands rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the expression "at least than 75 mg/m³" was deemed indefinite.

Claim 28 has been amended to address the concerns raised by the Examiner under 35 USC §112, second paragraph, and to lower the quantity of dust generated by the joint compound from 75 mg/m³ to 72 mg/m³. Support for the amendment appears in general throughout the Specification and in particular, for example, on page 15, Table 2 under the Control formulation. Applicant submits that the amendment to claim 28 renders the rejection under §112, second paragraph moot and respectfully requests reconsideration.

§ 102 and §103 Rejections

Claims 27 and 28 stand rejected under 35 USC § 102(b) as being anticipated by or, in the alternative, under 35 USC § 103(a) as being unpatentable over Williams (U.S. Patent No. 4,454,267), Struss et al. (U.S. Patent No. 4,686,253).

Claims 27 and 28 further stand rejected under 35 USC § 102(b) as being anticipated by or, in the alternative, under 35 USC § 103(a) as being unpatentable over Patel (U.S. Patent No. 5,653,797) or Smith et al. (U.S. Patent No. 4,286,995).

Anticipation requires the disclosure of each and every element of the claimed invention in a single prior art disclosure. None of the cited references disclose each and every element of the invention as defined in claim 27, as amended. In particular, none of the references discloses a method of reducing the quantity of dust generated by a drywall joint compound by first providing a drywall joint compound comprising filler, water, and at least one of a defoamer, wetting agent,

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preservative, fungicide, thickener, non-leveling agent, surfactant, solvent and binder, and then adding to that joint compound a dust reducing additive to reduce the quantity of dust generated by the joint compound. For this reason alone, claim 27 is believed to be patentably distinguishable over the cited references.

That is, claim 27 is patentably distinguishable over each of the cited references without knowing the degree to which the quantity of dust generated by the hardened joint compound of the present invention is reduced. Or stated another way, because the cited references fail to disclose adding a dust reducing additive to a drywall joint compound comprising filler, water, and at least one of a defoamer, wetting agent, preservative, fungicide, thickener, non-leveling agent, surfactant, solvent and binder as defined in claim 27, the additional limitation that the quantity of dust generated is reduced by at least 50% is not needed to patentably distinguish claim 27 from the cited references. Thus, the USPTO does need to have facilities to measure the quantity of dust generated to conclude that claim 27 is patentable over the cited references because the cited references fail to disclose other features of claim 27. If the Examiner elects to maintain the rejection of claims 27-28, however, Applicant requests the courtesy of an interview to discuss this issue and/or discuss what testing may be needed to overcome the rejection.

The Examiner's reliance on *In re Fitzgerald et al.* is misplaced because claim 27 defines a method of reducing dust, not a composition. Thus, the statement "an otherwise old composition is not patentable regardless of any new or unexpected properties" (emphasis added) is not relevant to the patentability of the method defined by claim 27.

Lastly, the Examiner's obviousness rejection based on Williams, Struss et al., Patel, and Smith et al, and in particular the statement "even if assuming that the prior art processes [or references] do not meet the requirements of 35 U.S.C. 102, it would still have been obvious to one of ordinary skill in the art, at the time the invention was made, to arrive at the same inventive process because the disclosure of the inventive subject matter *appears within the generic disclosure of Williams or Struss et al.*" (emphasis added) is not informative. As noted in M.P.E.P. § 706.02(j), after indicating that a rejection is under 35 U.S.C. 103, the examiner should set forth in the Office Action: "(A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate ..." The Examiner is therefore requested to indicate more specifically where the

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inventive subject matter appears in the disclosure of the Williams, Struss et al., Patel, and Smith et al. so Applicant can have an opportunity to present arguments directed to a specific rejection.

For the reasons set forth above, new claim 35 is also believed to be patentably distinguishable from the cited references. The remaining dependent claims, as depending from allowable claims, are also deemed to be in condition for allowance.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Respectfully submitted,

MARCH 4, 2005
Date

By: David B. Patchett
David B. Patchett, Reg. No.: 39,326
Telephone No.: (651) 736-4713

Office of Intellectual Property Counsel
3M Innovative Properties Company
Facsimile No.: 651-736-3833